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**Datasheet for the decision
of 25 March 2021**

Case Number: T 0998/17 - 3.2.04

Application Number: 05761954.6

Publication Number: 1802380

IPC: A63F3/06, B42D15/00, B32B7/12,
B32B15/12, B41M3/00, B41M7/00

Language of the proceedings: EN

Title of invention:

LOTTERY TICKET WITH METALIZED SCRATCH OFF LAYER

Patent Proprietor:

Pollard Banknote Limited Partnership

Opponent:

Scientific Games Holdings Limited

Headword:

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - (no)

Decisions cited:

T 1830/11, G 0001/99, T 0183/09

Catchword:



Beschwerdekammern

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Case Number: T 0998/17 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 25 March 2021

Appellant: Scientific Games Holdings Limited
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 February 2017 concerning maintenance of the
European Patent No. 1802380 in amended form.**

Composition of the Board:

Chairman J. Wright
Members: S. Oechsner de Coninck
W. Van der Eijk

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (opponent) against the interlocutory decision of the opposition division to uphold the patent in suit on the basis of the auxiliary request 1.
- II. Oral proceedings were held before the Board on 25 March 2021.
- III. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No.1802380 be revoked.

The respondent (proprietor) requested that the appeal be dismissed and the patent thus be maintained as upheld by the opposition division (main request), or auxiliarily, maintained on the basis of auxiliary request 1 or 2, both filed with letter of 6 April 2020, or on the basis of auxiliary request 3, filed at the oral proceedings before the Board.

- IV. The independent claims of the main request read as follows:

"1. A method of manufacturing a lottery ticket comprising:
providing a substrate layer (20);
defining a game area on a front surface of the substrate layer;
printing indicia defining game data (22) on the substrate layer in the game area;
the substrate layer (20) being arranged to or having one or more coatings (21) thereon which are arranged to

prevent access to the game data from a rear surface of the substrate;

applying at least one fixing layer (23) over the game data in the game area which is arranged to prevent release of the printed game data from the substrate layer;

applying at least one opaque scratch-off layer (25) over the at least one fixing layer,

a metal layer (29) being adhesively attached onto the opaque scratch-off layer;

and arranging the scratch-off layer (25) with the adhesive layer (28) and the portions of the metal layer (29) thereon such that the scratch-off layer, the adhesive layer and the portions of the metal layer separate from the at least one fixing layer and break down into fragments when scratched by a player;

CHARACTERIZED IN THAT the metal layer is adhesively attached by:

applying a rear surface of an adhesive layer (28) onto at least a part of a front surface of the previously applied opaque scratch-off layer (25) so that the adhesive layer when applied has an exposed front surface;

providing the metal layer (29) carried on a transfer carrier layer (44) so that the metal layer (29) has an exposed first surface and a second surface attached to the carrier layer;

contacting the exposed first surface of the metal layer (29) on to the exposed front surface of the adhesive layer (28);

and causing those parts of the metal layer (29) which are contacted by the front surface of the adhesive layer (28) to transfer from the carrier layer (44) onto the front surface of the adhesive layer (28) leaving other parts of the metal layer (29) which are not contacted by the front surface of the adhesive layer

(28) remaining attached to the carrier layer (44) such that the parts of the metal layer (29) which remain attached to the carrier layer (44) are carried away from the ticket, wherein an area on the substrate layer covered by the front metal layer (29) and the adhesive layer (28) covers only one part of an area on the substrate covered by the scratch-off layer (25)."

"6. A lottery ticket comprising:
a substrate layer (20);
a game area defined on a front surface of the substrate layer;
indicia defining game data (22) printed on the substrate layer (20) in the game area;
the substrate layer being arranged to or having one or more coatings (21) thereon which are arranged to prevent access to the game data from a rear surface of the substrate;
at least one fixing layer (23) applied over the game data in the game area which is arranged to prevent release of the printed game data from the substrate layer;
at least one opaque scratch-off layer (25) applied over the fixing layer, the scratch-off layer being arranged such that it separates from the fixing layer and breaks down into fragments when scratched by a player;
an adhesive layer (28) applied over at least a part of a front surface of the opaque scratch-off layer so as to be attached thereto;
and a front metal layer (29) adhesively attached onto the opaque scratch-off layer (25);
the front metal layer (29) and the adhesive layer (28) being arranged such that they break down into fragments with the scratch-off layer (25) when scratched by the player.

CHARACTERIZED IN THAT the scratch-off layer (25) is applied using a printing process (41) and the front metal layer (29) has a rear surface directly attached to the adhesive layer (28) and a front surface of the front metal layer providing a front surface of the lottery ticket which is exposed to view, wherein an area on the substrate layer covered by the front metal layer (29) and the adhesive layer (28) covers only part of an area on the substrate covered by the scratch-off layer (25)."

Independent claims 1 and 6 of auxiliary request 1 read as for the main request, except that the following wording is added to the end of both claims: "in the game area".

Independent claim 1 of auxiliary request 2 reads as for the main request, except that the last feature is amended to read as follows (with deletions and additions emphasised by the Board in strike-through and underline): "~~wherein an area on the substrate layer covered by the front metal layer (29) and the adhesive layer (28) covers only part of an area on the substrate covered by the scratch-off layer (25)~~ the metal layer (29) and the adhesive layer (28) cover only selected areas of the game area".

Independent claim 6 of auxiliary request 2 reads as for the main request, except that the last feature is amended to read as follows (again with deletions and additions emphasised): "~~wherein an area on the substrate layer covered by the front metal layer (29) and the adhesive layer (28) covers only part of an area on the substrate covered by the scratch-off layer (25)~~ wherein [sic] the metal layer (29) and the adhesive layer (28) cover only selected areas of the game area".

Auxiliary request 3 reads as for the main request, except for the deletion of the independent device claim (claim 6) and its dependent claims.

V. In the present decision, reference is made to the following documents:

E1 : WO 02/093474 A1

E3 : WO 03/020519 A1

E11: US 6358607 B1

VI. The arguments of the appellant-opponent can be summarised as follows:

E11 should be admitted into the proceedings.

The subject matter of claim 6 of the main request lacks an inventive step starting from E1 in combination with E11.

Auxiliary requests 1, 2 and 3 should not be admitted into the proceedings.

The subject matter of claim 1 of auxiliary request 3 lacks an inventive step starting from E1 combined with E3.

VII. The arguments of the respondent-proprietor can be summarised as follows:

E11 should not be admitted into the proceedings because it is late filed.

The subject matter of claim 6 of the main request involves an inventive step when starting from E1 and considering E11.

Auxiliary requests 1, 2 and 3 should be admitted into the proceedings.

The subject matter of auxiliary request 3, claim 1 involves an inventive step in the light of E1 with E3.

Reasons for the Decision

1. The appeal is admissible.
2. Background

The invention relates to a lottery ticket which includes a scratch-off layer covering game indicia which can be exposed by the player for playing the lottery. The invention also relates to a method of manufacturing a lottery ticket (see published patent specification, paragraph [0001] and claims 1 and 7).

According to the invention (see all versions of the independent claims), the lottery ticket has a front metal layer adhesively attached to the scratch-off layer.

3. Admission of document E11
 - 3.1 E11 was filed with the grounds of appeal. It is thus late filed and its admittance is subject to the discretion afforded by Article 12(4) RPBA (2007) with Article 114(2) EPC. E11 is said to have been filed as a response to the amended claims of the main request.

- 3.2 The Board notes (see impugned decision, facts and submissions, points 6 and 9) that just 1 month before the opposition oral proceedings, the proprietor withdrew all its previous auxiliary requests and filed 12 new auxiliary requests. During the oral proceedings, auxiliary request 12 was made the first auxiliary request and is the current main request.
- 3.3 This request combines granted claims 7 and 10. In so doing, it raised to prominence, for the first time, the feature of the front metal layer and adhesive layers covering only a part of the scratch-off layer as an indispensable feature of the invention.

According to established jurisprudence (see Case Law of the Boards of Appeal, 9th edition, 2019 (CLBA) V.A. 4.11.3.c, in particular T1830/11, headnote and reasons, part 1) there are no provisions in the EPC which oblige the opponent to provide evidence against every possible fallback position defined in dependent claims.

In the present case, it is true that the proprietor filed auxiliary requests 1 to 12 in opposition just within the 1 month time limit defined by Article 116 EPC. The circumstances of the present case are therefore different from T1830/11 where a new request combining dependent claims was filed at oral proceedings.

Nevertheless, in the Board's view, just as an opponent cannot be expected to know which claim of a set of granted dependent claims might be used to uphold a patent, so too could the opponent in the present case not have known which of the 12 auxiliary requests on file at the start of the opposition oral proceedings might eventually be used to uphold the patent. This

only became clear at the oral proceedings. Under these circumstances, the Board considers that filing E11 at the earliest opportunity in appeal was a timely reaction to the impugned decision. In other words, the Board considers E11 to have been filed in due time in the sense of Article 114(2) EPC.

3.4 Moreover, the Board considers E11 (see for example abstract, column 4, lines 22 to 26 and figure 5a) to be *prima facie* relevant to claim 1, since it discloses scratch-off labels where a front security element 6 is adhesively attached to the scratch off layer 5 and extends only partly over the scratch off layer.

3.5 For these reasons, the Board decided to exercise its discretion under Article 12(4) RPBA with Article 114(2) EPC by admitting document E11 into the proceedings.

4. Main request, claim 6, inventive step starting from E1 with E11

4.1 E1 discloses a lottery ticket (see for example page 1, lines 6 and 7, page 8, lines 1 to 5 figures 1 and 2 and claim 31).

4.2 In summary, E1's lottery tickets have a game area in which game data indicia are printed (cover information - see page 2, lines 25 to 29). A fixing layer is applied over the game data (see page 10, lines 1 to 5 with figures 7 and 9 - layer 8). Over the fixing layer an opaque scratch-off layer 7 is applied (see page 9, line 26). Such layers break down into fragments when scratched (see page 1, lines 18 to 25). An adhesive layer is applied over the opaque scratch-off layer 7 (see page 9, lines 22 to 26 - layer 6).

A front metal layer - layer 5 - is adhesively attached to the scratch-off layer (see page 9, lines 21 to 22). Since E1's scratch-off layer breaks down into fragments when scratched, so too will the overlying adhesive and metal layers.

Thus, E1 discloses the preamble of claim 6 - which is the same as for granted claim 7 - as indeed the patent confirms (see published patent specification, paragraph [0015]).

- 4.3 The Board disagrees with the opposition division's finding (cf. impugned decision, reasons, 2.4) that E1 does not disclose that the scratch-off layer is applied using a printing process. E1 discloses (page 9, lines 26 to 30) to use scratch-off inks. In a broad context ink does not have to be applied by printing, for example it could be painted on by hand. However, in the present context of a lottery ticket, produced in an automated way and which already has other elements provided by printing (see for example, page 5, lines 1 to 3, page 11, lines 3 to 5), the Board holds that the use of ink to make the scratch off layer in such an automated way can only mean that it is applied by some kind of printing process. In this respect, the Board is not convinced by the respondent-proprietor's argument that the ink could be applied by a transfer process, which would not be printing. This is because such a transfer process with ink would involve pressing ink onto a surface to leave an imprint, which is a form of printing. The Board also finds it implausible that ink might be painted onto the security device by some kind of automated painting tool when producing lottery tickets as the respondent-proprietor has argued. Thus, the Board holds that it is implicit that in E1 the scratch-off ink is printed.

- 4.4 In the Board's opinion, E1 also discloses that a front surface of the front metal layer provides a front surface of the lottery ticket which is exposed to view as claimed. In particular, the feature defines that the metal layer provides a front surface in the sense of its being *exposed to view*. This does not require its also being exposed to touch as the respondent-proprietor would have it. In other words, the metal layer must be visible when the user looks at the front of the lottery ticket, but does not need to form the absolute exterior of the ticket.
- 4.5 In E1, the aluminium layer 5 is part of a hologram layer which has a thermoplastic embossing layer 3 and an optical variability producing microstructure layer 4 above it to produce an optical effect. E1 refers to this structure as a diffractive optically variable image device - DOVID (see page 1, lines 34 to 36 and page 9, lines 20 to 21 with figures 7 and 9, which show the same layers 3 and 4 as figures 1 and 2). The purpose of the DOVID's aluminium layer is to enhance reflection. Therefore, it provides a front surface of the lottery ticket which is exposed to view as claimed.
- 4.6 However, in the Board's view, E1 does not disclose the last claim feature (the front metal / adhesive layers cover only part of an area on the substrate covered by the scratch-off layer).

In E1 (see page 6, lines 17 to 20 and page 13, lines 7 to 11 with figure 9), the DOVID is transparent in certain areas 18 so that the scratch-off layer is visible. Since metal is opaque, this transparency can only be achieved by the metal layer not extending over the whole of the DOVID. Indeed, this appears to be

indicated by the broken line of the metal layer 5 in the areas 18 (cf. page 4, lines 33 to 37), whereas the adhesive layer 6 appears to be continuous.

4.7 In examining inventive step, a first consideration is what technical effect this differing feature has.

In this regard the patent first states (see published patent specification, paragraphs [0021] and [0034]) that the metal / adhesive layers may cover all of the game area, a part or parts of it. It goes on to explain (see paragraph [0047], first sentence) that the metallic layer may simply be decorative rather than a security coating, so may be applied only over a part of the game area giving the opportunity for different graphics effects. Therefore, beyond the graphic effect of the user seeing some parts of the scratch-off layer whilst other parts are hidden by the metallic layer, the patent does not suggest any technical effect arising from the differing feature (*partial coverage*), let alone one of increased security as the respondent-proprietor has suggested.

Paragraph [0047] (see second sentence) continues by explaining that, *even if the metallic layer is applied to only selected areas it may still provide additional security effects*. Here the conditional clause *even if* confirms that no enhanced security is achieved by partial metallisation: rather, any security effect achieved by the metallic layer as such *may* be retained even with only partial coverage of the scratch-off layer. This is consistent with the third and final sentence which gives the example of a metallic layer enhancing security by protecting against compromising the device with chemicals. In the Board's view, the protection afforded by such a layer could not be

increased by decreasing its extent. Rather, only where the metallic layer is present might it protect against chemicals.

- 4.8 Therefore, this differing feature (metal/adhesive layers cover only a part of the scratch-off layer) merely has the graphic effect of exposing some parts of scratch-off layer to view whilst others are metallised.
- 4.9 E1 (see page 6, lines 17 to 20) achieves the same graphic effect by making the DOVID transparent in parts to expose the underlying scratch-off layer to view.
- 4.10 Therefore, the objective technical problem can be formulated as: how to modify E1's lottery ticket to expose the scratch-off layer to view in an alternative way.
- 4.11 In the Board's view, faced with this problem, the skilled person would consult E11 for a possible solution, since it also relates to devices which conceal secret information with a scratch-off layer (see column 1, lines 5 to 8 and column 2, lines 24 to 29). Moreover, like E1, E11 discloses to overlay the scratch-off layer with a hologram (see column 3, lines 5 to 10).
- 4.12 In this respect the respondent-proprietor has argued that the skilled person would not combine E1 and E11 because E11 does not mention a lottery ticket.

In particular, the respondent has alleged, but without providing any supporting evidence, that lottery tickets use different technology to other security devices such as those concealing a bank pin code (cf. E11, column 1,

lines 10 to 17) because the former involve greater sums of money.

- 4.13 The Board does not find this convincing. The fundamental idea of a scratch card device is to cover up secret information with a scratch-removable layer, regardless of what the secret information might represent (for example a lottery number or bank pin code). Because E1 and E11 both relate to scratch cards, the skilled person would consider combining their teachings.
- 4.14 Reading E11, the skilled person will see that in one embodiment (see column 4, lines 22 to 26 with figure 5a), the scratch-off layer 5 is partially covered by an authentication mark 6 and partially exposed. In the Board's view, the skilled person would immediately realise that the authentication mark's partial coverage offers an alternative way of exposing parts of the scratch-off layer.
- 4.15 Therefore, the Board holds that it would be obvious for the skilled person to modify E1's DOVID hologram layer so that, instead of having a transparent part, it only covered a part of the scratch-off layer. In so doing, the skilled person would arrive at the subject matter of claim 1 without having made an inventive step.
- 4.16 In this regard, the respondent-proprietor has argued that the skilled person would not modify the lottery ticket of E1 in this way because a fundamental security concept of E1 is to have first indicia in the DOVID which graphically relate to or cooperate with second indicia elsewhere (see for example page 2, lines 22 to 29) and therefore the skilled person would not abandon E1's arrangement whereby the DOVID extends across the

entire scratch-off layer. The Board disagrees. Whether the DOVID extends over a part or all of the scratch off layer has no influence over what graphic indicia it might have.

4.17 The respondent-proprietor has also argued that the skilled person would not consider the teaching of E11's figure 5a because it is not clear from that embodiment whether the authentication mark is merely an overprint, a hot embossed foil, with or without a hologram or an engraving in the scratch-off layer (cf. E11, column 4, lines 5 to 14). In other words, it is not directly and unambiguously disclosed that the authentication mark incorporates a metallic layer, so the skilled person would not consider this embodiment as providing any information as to how to modify the lottery ticket of E1, with its metal layer as part of a DOVID. The Board disagrees.

4.18 E1 already tells the skilled person how to apply an optical effect with a metal layer (the DOVID). Therefore the skilled person is not looking to E11 to teach them how to do this. Rather, their mind is focused on finding an alternative way of exposing the scratch-off layer to view. In the Board's opinion, the skilled person will immediately see from figure 5a and column 4, lines 22 to 26 that the authentication mark 6 provides such an alternative, simply by not extending completely over the scratch-off layer, irrespective of the technology used to make it.

Put differently, it is entirely within the skilled person's normal skills of comprehension and abstraction to recognise that this aspect can be applied broadly, namely with any form of authentication mark, what ever kind figure 5a might show.

- 4.19 For all these reasons, the Board concludes that the subject matter of claim 6 of the main request lacks an inventive step. Therefore this request fails.
5. Auxiliary requests 1 and 2, admittance
- 5.1 Auxiliary requests 1 and 2 were not filed with the respondent proprietor's reply to the appeal but only after the summons and the Board's communication had been issued. Their admittance is at the Board's discretion under Articles 13(1) and 13(3) RPBA 2007 (see Article 25(3) RPBA 2020) taking into account, amongst other things, the need for procedural economy.
- 5.2 No justification for the late filing of these submissions has been given, nor is any apparent to the Board. Moreover, neither request appears, *prima facie*, to be appropriate for overcoming the deficiencies found for the main request (lack of inventive step), without raising new issues. Nor has the respondent-proprietor argued to the contrary.
- 5.3 Regarding auxiliary request 1, claim 6 adds the feature that the area covered by the front metal layer and the adhesive layer is *in the game area*. In E1 (see figure 9), this is likewise the case - the game area being at least the area having the data 12, above which the metal layer 5 and adhesive layer 6 are provided. Therefore, the added feature does not appear suitable for rendering the subject matter of claim 6 inventive.
- 5.4 Regarding auxiliary request 2, this request deletes a feature from claim 6 (and claim 1) as maintained, namely that *an area on the substrate layer covered by the front metal layer and the adhesive layer covers*

only part of an area on the substrate covered by the scratch-off layer. This deletion broadens the scope of claim 6 beyond that which was maintained. Allowing this request of the non-appealing respondent would, at least in this respect, put the appealing party (the opponent) in a worse position than it would have been in had it not appealed. Therefore, the request appears to fail under the prohibition of *reformatio in peius* (see G1/99, headnote).

- 5.5 For these reasons, the Board decided to exercise its discretion under Article 114(2) EPC with Article 13(1) RPBA 2007 and Article 25(3) RPBA 2020 by not admitting auxiliary requests 1 and 2 into the proceedings.
6. Auxiliary request 3, admittance
 - 6.1 The auxiliary Request 3 was filed at the latest possible point in time, that is, not until during the oral proceedings before the board. The revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020) entered into force on 1 January 2020, Article 24(1) RPBA 2020, i.e. after notification of the summons to oral proceedings. Therefore, Article 13 of the Rules of Procedure of the Boards of Appeal in the version valid until the date of the entry into force of the revised version (RPBA 2007) continues to apply, Article 25(3) RPBA 2020.
 - 6.2 The admissibility of the request at that very late stage of the proceedings is thus subject to the discretion of the board under Article 13(3) RPBA 2007. According to that article, amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the

other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

- 6.3 During the oral proceedings, the Board found the subject matter of device claim 6 of the main request (as upheld) to lack inventive step starting from E1 in combination with E11. In response the respondent-proprietor filed the auxiliary request 3, which, by deleting all device claims, was limited to the method claims of the patent as upheld. The deletion of all device claims in auxiliary request 3 undoubtedly addressed not only that inventive step objection but all other objections raised against the device claims, such as added subject-matter, by rendering them moot. Only those objections that the other party had to date validly raised against the method claims of the patent as maintained remain.
- 6.4 Because these issues had already been raised previously the deletion of the device claims does not give rise to any new issues. Moreover, the other party, having raised these issues previously, and the Board could be expected to deal with with them without adjournment of the oral proceedings. For these reasons, the board decided to admit auxiliary request 3 into the proceedings, Article 13(1) RPBA 2007 with Article 114(2) EPC.
7. Auxiliary request 3, claim 1, inventive step starting from E1 with E3
- 7.1 Claim 1 (which is the same as claim 1 of the main request) defines a method of manufacturing a lottery ticket. The features of claim 1's preamble correspond to those of the preamble of claim 6 of the main request, albeit expressed in terms of method steps. It is not in dispute that E1 discloses all these features

(cf. above, point 4.2 and the published patent specification, paragraph [0015]).

7.2 The characterising features of claim 1 are as follows (with feature numbering that has been used by the parties added by the Board):

1.10 applying a rear surface of an adhesive layer onto at least a part of a front surface of the previously applied opaque scratch-off layer so that the adhesive layer when applied has an exposed front surface;

1.11 providing the metal layer carried on a transfer carrier layer so that the metal layer has an exposed first surface and a second surface attached to the carrier layer;

1.12 contacting the exposed first surface of the metal layer on to the exposed front surface of the adhesive layer;

1.13 and causing those parts of the metal layer which are contacted by the front surface of the adhesive layer to transfer from the carrier layer onto the front surface of the adhesive layer leaving other parts of the metal layer which are not contacted by the front surface of the adhesive layer remaining attached to the carrier layer such that the parts of the metal layer which remain attached to the carrier layer are carried away from the ticket,

1.14 wherein an area on the substrate layer covered by the front metal layer and the adhesive layer covers only part of an area on the substrate covered by the scratch-off layer.

7.3 It is not disputed that E1 does not disclose the characterising features 1.10 to 1.14.

- 7.4 Features 1.10 to 1.13 define a transfer process by which the metal layer starts off being attached to a transfer carrier layer, but which is then, partly transferred to the scratch-off layer by adhering it thereto where adhesive is present.
- 7.5 In the Board's view, E1 is silent as to whether the arrangement shown in figure 9 is assembled by a transfer process or built up as a label. Whilst E1 explains that both ways of making a security device are possible (see page 6, lines 33 to 36), it simply does not disclose how the particular device of figure 9 is made, other than that the first indicia 12a are printed (cf. page 12, lines 12 to 15 and page 13, lines 7 to 13).
- 7.6 As to the last claim feature, 1.14, E1's method does not result in an area of the substrate covered by the front metal and adhesive layers covering only a part of the scratch-off layer. As already explained for the main request, in E1 figure 9, although there are gaps in the metal layer that provide transparency, there appear to be no gaps in the adhesive layer 6.
- 7.7 Considering the differing features explained above, the Board notes that the patent (see for example the published patent specification, paragraphs [0031], [0041] and [0042] with figure 4) does not disclose any particular advantage of providing the metal layer by a transfer process. The process is merely described. Therefore, the Board agrees with the parties that the objective technical problem can be expressed as how to adapt the method of making a lottery ticket according to E1 to provide an alternative way of applying the metal layer (cf. E1, figure 9, layer 12 with its

transparent regions 12a, where metal is not continuously present).

- 7.8 In the Board's view, E3 offers such an alternative. In particular (see page 4, 3rd and 4th paragraphs, and page 6, 3rd and 4th paragraphs and page 11, 3rd paragraph to page 14, 2nd paragraph with figure 4), E3 proposes to print an adhesive pattern 37 onto a substrate 34, then to transfer a metal foil 10 mounted on a release layer onto the adhesive pattern as the foil/release layers pass between the guide rollers 46, 48. Only where there is adhesive will the foil be transferred, the rest is carried away on the carrier layer, as explained on page 13, last but one paragraph to page 14, 2nd paragraph.
- 7.9 Therefore, faced with the objective technical problem (alternative way of applying the metal to parts of the scratch-off layer), the skilled person would apply the technique disclosed in E3 and thereby arrive at the differing features, as a matter of obviousness.
- 7.10 In this regard, the Board notes that, because in E3 the adhesive is applied as a pattern, there will inevitably not be a continuous adhesive layer but only directly underneath the metal foil in the finished product. Therefore, the resulting method would satisfy the last feature of claim 1, feature 1.14.
- 7.11 The respondent-proprietor has argued that an important aspect of E1's teaching (see again page 9, lines 19 to 22 with figure 9) is to provide a thermoplastic embossing layer 3 and an optical variability producing microstructure 4 above the metal layer 5, therefore, so the respondent reasons, the skilled person would not abandon these layers, retaining only the metal layer.

Thus, according to the respondent, the combination of E1 and E3's teaching would lead to the application of E1's metal layer together with its overlying embossing layer 3 and optical variability producing microstructure 4 by a transfer method. The Board finds this plausible.

However, E3's method is not restricted to only transferring a metal layer. The foil to be transferred may include several layers (see page 6, 4th paragraph, 1st to 3rd sentences).

- 7.12 Moreover, the Board does not agree with the respondent-proprietor's further argument that claim 1's feature 1.11 implicitly results in the manufacture of a ticket where the metal layer is the outermost layer.

According to this feature, the second surface of the metal (the one initially attached to the transfer carrier layer) is not said to be directly attached to the carrier layer. Feature 1.11 merely requires some kind of attachment (direct or indirect) between the metal's second surface and the carrier layer. In other words, the feature does not exclude there being other layers between the surface of the metal and the carrier layer.

- 7.13 Thus, in solving the problem of modifying E1 to provide an alternative way of applying the metal to parts of the scratch-off layer, the skilled person would use E3's transfer method to transfer E1's metal layer and overlying embossing layer 3 and optical variability producing microstructure 4 to those areas of the scratch-off layer that should be covered by metal (by applying adhesive there), but not to those parts which should be visible (where there is no adhesive). In so

doing the skilled person would arrive at the subject matter of claim 1, as a matter of obviousness.

7.14 Therefore, the subject-matter of claim 1 lacks inventive step and auxiliary request 3 fails.

8. Since the respondent-proprietor's main request and auxiliary request 3 lack inventive step, Article 56 EPC and the remaining requests - auxiliary requests 1 and 2 - have not been admitted into the proceedings, the Board must revoke the patent.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Magouliotis

J. Wright

Decision electronically authenticated